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In re Application of	:
Ron S. Israeli et al	:
Serial No.: 08/470,735	: DECISION ON PETITION
Filed: 06 June 1995	:
Attorney Docket No.: 1769/41426-D	:

This letter is in response to the petition under 37 C.F.R. 1.313(a) filed 16 June 2004 requesting withdrawal of the above-identified application from issue. The delay in acting on this petition is regretted.

BACKGROUND

On 20 April 2004 the examiner mailed to applicants a Notice of Allowability and a Notice of Allowance and Issue Fee Due setting a three month statutory period for payment of the Issue Fee and to submit new formal drawings. Claims 128-144 and 161 were indicated as allowable by the examiner in the Notice of Allowability (note – claim 139 was canceled by Examiner's amendment). The issue fee was indicated as due on 20 July 2004.

On 16 June 2004 applicants filed an amendment under 37 CFR 1.312 requesting entry of an amendment after the Notice of Allowance in which it was proposed to amend claims 128-138 and 141 and cancel claims 139-140.

On 16 June 2004, applicants also filed a Supplemental Information Disclosure Statement citing four new references, but not discussing them. The only comment was that they had been cited in a related Japanese application on 2 March 2004.

On 16 June 2004 applicants filed a petition under 37 CFR 1.313(a) requesting that the instant application be withdrawn from issue.

On 22 July 2004 applicants filed comments on the Examiner's reasons for allowance.

The Issue was recorded as received on 23 July 2004 (Certificate of Mailing dated 20 July 2004) and is considered timely received.

DISCUSSION

The above file history has been carefully considered.

Petitioners explain that they received an untranslated copy of a Japanese patent examiner's office action mailed to them by their Japanese associates on 05 March 2004. In this same communication the Japanese associates stated that an English translation of the Office action would be sent shortly thereafter. This communication was addressed to Mark A. Farley, an attorney with Cooper & Dunham at the time. On 17 March 2004 Mr. Farley forwarded a copy of this letter from the Japanese associates to the client and the legal representatives of a licensee and a sublicensee. On 29 March 2004, Cooper & Dunham received a copy of an English translation of the Japanese official action mailed 02 March 2004, identifying the four references used in the art rejections.

On March 30, 2004 Mr. Farley's affiliation with Cooper & Dunham ended. Another attorney, Cindy Yang, prepared a letter dated 06 April 2004, to be sent by Cooper & Dunham to the client, the legal representatives of the licensee, and the sublicensee that included a copy of the English translation of the Japanese Office action and copies of the four prior art references.

On 04 June 2004, Edward Gates, an attorney representing a sublicense notified Cooper & Dunham that the four references cited by the Japanese Patent Office should be considered in terms of making them of record in this application.

Following a telephone conference call which Ms. Yang had with Special Programs Examiner William Dixon, Jr. and Jasmine Chambers, Director of Technology Center 1600, petitioners filed the instant Petition to Withdraw the application from Issue under 37 CFR 1.313(a) and concurrently an Amendment After Notice of Allowance under 37 CFR 1.312.

The established procedure provided by the PTO for submitting additional references for consideration by an examiner after allowance of an application is to file an Information Disclosure Statement under CFR 1.97 (d) (1) - (3) . A proper submission under 37 CFR 1.97(d) (1) - (3) requires that applicants submit (1) a petition requesting consideration and fee therefore; (2) a fee in accordance with §1.17(p); and (3) a certification (37 CFR 1.97(e)):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or

That no item of information contained in the information disclosure statement was cited in a communication from foreign application, and to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in §1.56(c) more that three months prior to the filing of the information disclosure statement.

However, any submission under 37 CFR 1.97(d) or (e) was excluded because applicants could not provide either of the above required certifications.

Therefore, applicant is requesting that, instead, the instant application be withdrawn from issue under 1.313(a) so that the IDS might be considered by the examiner.

37 CFR 1.313(a) states, in part:

Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in 37 CFR 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application is required.

As such, a grantable petition requesting withdrawal of an application from issue must be accompanied by: (1) a showing of good and sufficient reasons why withdrawal of the application from issue is necessary; and (2) the requisite petition fee under 37 CFR 1.17(h). **The petition of \$130 has been charged to petitioners' Deposit Account No. 03-3125 .**

The petition fails to set forth any good or sufficient reason as to why withdrawal of the application is necessary. The mere submission of an IDS with the petition does not make withdrawal of the application from issue necessary. There are other avenues open to applicants to have an IDS considered other than by way of petition. Applicants may request reexamination of an issued patent under 37 CFR 1.510. However, applicants are precluded from filing a Request for Continued Examination under 37 CFR 1.114 in order to have the IDS considered in view of the filing date of the application. A continuing application under 35 U.S.C. 111, however, could be filed.

The IDS submitted 20 July 2004 lacks the required certification under CFR 1.97(e) or the good and sufficient reasons required by 1.313(a). Therefore, the only other basis for requesting withdrawal from issue would be under 37 CFR 1.183.

In order for grant of any petition under 37 CFR 1.183, petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985). In other words, the only possible remedy for applicants would be waiver of a Rule for conducting business before the Office is necessary in order to preserve applicants' property rights. Petitioner has not shown that such condition exists in this case. Petitioner has not demonstrated that the lack of a certification was caused by "extraordinary circumstances" such that "justice requires" waiver of the requirement for certification set forth in 37 CFR 1.313(a).

Moreover, petitioners have a suitable remedy on hand that does not require the extraordinary remedy of invoking 37 CFR 1.183, i.e., filing of a continuation application under 35 U.S.C. 111 or a request for a re-examination subsequent to issuance of the patent. It is brought to petitioners' attention that the Office will not normally consider an extraordinary remedy, when

the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664, 665 (Comm'r Pat, 1982). As set forth in MPEP §609, applicants wishing to have the Office consider an IDS, where, as apparently herein, the necessary certification cannot be made, should consider filing of a continuing application, wherein the applicants may bring the references to the attention of the examiner without having to also tender a certification. While the petitioner may be concerned about the loss of term should a continuing application be necessary to have the proffered references considered, the underlying delay necessitating such an action is that of the petitioner, not the Office. Moreover, the statutes and regulations do not compel an applicant to claim benefit under 35 U.S.C. 120 of any earlier case that might shorten the term of a forthcoming patent under 35 U.S.C. 154. However, should petitioner desire to be entitled to the potential benefits of earlier application(s) via 35 U.S.C. 120, then petitioner must also accept the consequences attendant to that action. See Abbott Laboratories v. Novopharm Ltd., 38 USPQ2d 1309, 1312 (D.C.N. II, 1996), *aff'd* 104 F.3d. 1305, 41 USPQ2d 1535 (Fed. Cir. 1997).

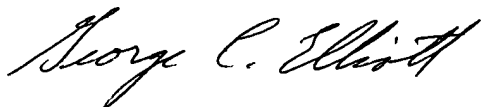
DECISION

For all of the above reasons, the petition under 37 CFR 1.313(a) requesting withdrawal of the application from issue is **DENIED**.

The four references submitted in the Information Disclosure Statement will be placed in the file but will not be considered as provided for in 37 CFR. 1.97(i). The amendment under 37 CFR 1.312 will be considered by the examiner.

Any request for reconsideration of this decision must be filed within two (2) months of the mailing date of this decision in order to be considered timely.

Should there be any questions regarding this decision, please contact Special Program Examiner, William R. Dixon, Jr. by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.



George C. Elliott
Director, Technology Center 1600